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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,517	07/31/2001	Takahiro Okada	P/1071-1422	3623

7590

11/21/2002

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EXAMINER

CHO, JAMES HYONCHOL

ART UNIT	PAPER NUMBER
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2819

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,517

Applicant(s)

OKADA ET AL.

Examiner

James H. Cho

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed September 18, 2002.

Claim Objections

2. Claim1 is objected to because of the following informalities:

in claim 1, "a open" in line 4 appears to be --an open--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Tada et al. (US PAT No. 6,087,911).

Regarding claim 1, Fig. 14 and Fig. 15 of Tada et al. teaches a dielectric filter comprising a dielectric block (12); a plurality of conductive through holes (14) arranged in the dielectric block, each of the conductive through holes having an open end along a first surface of the dielectric block (12a); a respective coupling electrode (17 and 18) connected to each conductive through hole (14), each coupling electrode formed on the first surface of the dielectric block and extended at least to a first edge of the dielectric

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block (17 and 18 are extended to the edge), the respective coupling electrodes having a gap therebetween (two 14 are separated each other) and generating a capacitance therebetween (capacitance between two separated electrodes is inherent in a dielectric filter) so as to couple the plurality of conductive through holes; and an outer conductor (15) arranged on outer surfaces of the dielectric block.

Regarding claim 2, Fig. 14 and Fig. 15 of Tada et al. teaches the dielectric filter according to claim 1, where the coupling electrodes further extend onto a second surface of the dielectric block which intersects the first edge of the dielectric block (17 and 18 are extended onto the top surface of 15 in Fig. 14).

Regarding claim 3, Fig. 14 and Fig. 15 of Tada et al teaches the dielectric filter according to claim 1, further comprising input/output electrodes (17 and 18 on surface 15 in Fig. 15; col. 10, lines 52-65) arranged on a second surface of the dielectric block and extending from a second edge (17 and 18 extended from the edge in Fig. 15), opposing the first edge, to generate capacitance between the open ends of the conductive through holes and the input/output electrodes (capacitance between the open ends of the conductive through holes and the input/output electrodes is inherent in a dielectric filter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (US PAT No. 6,087,911) in view of Tsukamoto et al. (US PAT No. 6,351,198).

Regarding claims 4-6, Tada et al. discloses the dielectric filter according to claim 3, but does not teach or fairly suggest a dielectric duplexer comprising a pair of the dielectric filters according to claim 3, a communication apparatus comprising a high-frequency circuit connected to the dielectric filter according to one of claims 1 and 2, or a communication apparatus comprising a high-frequency circuit connected to the dielectric duplexer according to claim 4. However, Fig. 5 of Tsukamoto et al. shows and teaches the use of the dielectric filter in a communication apparatus as a duplexer with a high frequency circuit for the purpose of designing a communication device. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to construct a communication apparatus having the dielectric duplexer of Tsukamoto et al. with a dielectric filter of Tada et al. because it is mere intended use of a dielectric filter. It has been held that a recitation directed to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Allowable Subject Matter

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Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claim 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Cho whose telephone number is 703-306-5442. The examiner can normally be reached on Monday-Friday, 05:30am-02:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 703-305-3493. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0142 for regular communications and 703-308-0142 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JHC
November 18, 2002


Michael Tokar
Supervisory Patent Examiner
Technology Center 2800